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No. 87-489

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1987

COHERENT, INC.,
Petitioner,

vs.

SPECTRA-PHYSICS, INC.,
Respondents.

REPLY BRIEF ON PETITION FOR WRIT OF CERTIORARI

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Respondent claims that this case has no general importance. The decision of the Federal Circuit below has been reported at 827 F2d. 1524 and 3 USPQ2d 1737, and it has been reviewed in *The BNA's PATENT, TRADEMARK AND COPYRIGHT JOURNAL,* Vol. 34, Page 433, (8-27-87).

The decision below is important simply because it is a big case and a well known case in an important high technology industry, and the decision of the Federal Circuit denies patent protection by implying concealment in the face of an express finding by the trial court that the inventors were not guilty of concealment either intentionally or accidentally.

This was a three month trial in which Respondent asserted virtually every defense known to patent cases. Respondent's brief attempts to confuse the issues before this court by rehashing

many of those defenses which it lost before both courts below,[1] but the fact remains that the decision of the Federal Circuit is based on a single clear-cut issue, an appellate court implying concealment in the face of contrary findings of the trial court.

That decision sends the message to the high technology industry that patents really don't protect your products, and the patent litigation process, which is unbelievably expensive, is wide open to the very last minute for a judge to second guess everyone who came before him or her and substitute his or her own personal inferences for the deliberate findings that have been made.

Respondent argues that the appeals court was merely doing the same thing that the trial court did on different grounds, holding the patents invalid for an inadequate disclosure. The decisions of the two courts are much different. The finding of no enabling disclose of the trial court was clearly wrong, and reversed, because the disclosure in the patents of Moly-Manganese brazing which respondent used enabled a reader of the patent to make the invention. Enablement is an objective fact. The appellate court's finding that the best mode of the invention was not disclosed is much different, because it must be based on concealment. That is a subjective issue on which an appellate court should not substitute its inference for the findings of the trial court.

The decision below, aside from being wrong, has a chilling effect on those in the high technology industry who would rely on patents. It is a ray of hope to the would be infringer that it may be worth playing out the expensive game of patent infringement

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[1] Respondent argues that its own inventors, Wright & Riley, had done work which "was essentially the same as that done by Coherent with one exception, namely, Coherent solved the brazing problem . . . " (Respondent's brief, page 2) Respondent lost on this issue below. The Jury found that Wright & Riley had not reduced the invention to practice, (A-38, question 1) and the jury also found that the claims to which this appeal is directed were unobvious and infringed (A-41 & 43, questions 12, 13, 17 & 18). These claims included an ion shield which is the principal element of the invention which Wright & Riley did not make (A-41, question 11) and which Respondent later copied from Coherent to make its laser work.

litigation to the very end because you may pull it out at the appellate level by getting an appellate judge to draw an inference of his or her own. The patent system is vitally important of our economy, and this court should prevent it from being undermined by the decision below.

Apart from the strong public interest in the decision below and recognizing the demands on this court, Petitioner asks this court for review because it has been hurt by the decision below. Dr. Hobart and Mr. Mefferd made a good faith disclosure of their invention, in the same detail as the established practice in laser patents, and the disclosure was sufficiently detailed for competitors to copy the invention. The Federal Circuit held the patents invalid by implying that the inventors had concealed something which the infringer didn't even need to know when it copied the "devastatingly competitive new product." Where the "braze cycle" was so unimportant that Respondent didn't need to use it, it isn't so important that the Federal Circuit should imply concealment in the face of contrary findings of the trial court.

Respectfully Submitted,

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